

Remarks

Claims 1-6, 8-10, and 12-22 are pending in the Application. Claim 6 has been amended to include the subject matter of original claim 7. Claims 7 and 11 have been canceled without prejudice. Claim 12 has been amended to depend from claim 1, as claim 11 from which it originally depended has been canceled. Claim 14 has been amended to correct a typographical error. Claims 18-22 have been added. Claims 18 and 20 find support in the Specification, for example note original claim 1; the Abstract; page 61, lines 3-11; and page 84, lines 7-10.

Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Claim Status

Claim 1 was rejected under 35 U.S.C. § 102(b) over Gardner (US 5,861,614).

Claims 2-17 were rejected under 35 U.S.C. § 103(a) over Gardner in view of Werth (US 4,369,442).

The 35 U.S.C. § 102(b) Rejection

The Action alleges that Gardner teaches an ATM (10) and a portable diagnostic article (card 99). The Applicant respectfully traverses the rejection of claim 1.

Gardner does not anticipate step (b). Gardner does not output diagnostic indicia that corresponds to stored diagnostic data. Where does Gardner teach diagnostic data *stored in* an automated banking machine. Where does Gardner relate stored diagnostic data to a transaction function device condition?

Gardner also does not anticipate step (c). Gardner does not output indicia that corresponds to *service data stored on* a portable diagnostic article. No evidence has been presented that Gardner's card (99) (i.e., the alleged portable diagnostic article) has *service data* stored thereon. Conversely, the card (99) appears to be used merely for availability of a "standard magnetic stripe card" (col. 6, line 7). Even if it were somehow possible (which it is not) for Gardner to teach the card (99) having service data, Gardner would still lack a teaching of *outputting indicia* that corresponds to that service data. Gardner is concerned with receiving diagnostic-type messages from the microcomputer (32), not outputting service data from the card through an output device. It follows that Gardner does not anticipate claim 1.

The 35 U.S.C. § 103(a) Rejections

The Action's assertions are not based on any evidence in the record and thus lack substantial evidence support for the rejection. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Nor is the determination of non-patentability in the Action based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Claim 2

The Action admits that Gardner does not teach or suggest diagnostic indicia corresponding to a currency dispenser device condition. Werth cannot alleviate the admitted deficiencies of Gardner as it does not teach or suggest the recited features which are not found in Gardner. Werth is directed to vending machines. One skilled in the art would recognize that Werth's vending machine is non analogous to Gardner's ATM. Werth cannot perform a diagnostic for Gardner's ATM cash dispenser.

Furthermore, where does Werth teach or suggest outputting diagnostic *indicia*, especially *indicia* corresponding to a condition of a currency dispenser device (step b)? Nor has the Office explained how Gardner's magnetic stripe card (99) for a card reader can be used to perform a diagnostic test for a cash dispenser, as alleged.

Additionally, Werth cannot alleviate the admitted deficiencies of Gardner with respect to step (c) as he likewise does not teach or suggest outputting *indicia* that corresponds to service data stored on a portable diagnostic article. The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps. The Office has not established a *prima facie* showing of obviousness.

Claim 15

The references, taken alone or in combination, further do not teach or suggest providing a secret code on a portable diagnostic article. Nor do the references, taken alone or in combination, output *indicia* responsive to the secret code being an authorized code. Thus, the Office has not established a *prima facie* showing of obviousness.

The New Claims

Claim 18

The references, taken alone or in combination, further do not teach or suggest that responsive to operatively engaging a portable diagnostic article with an automated banking machine component, operating the machine to enable an authorized machine servicer to access (from the portable diagnostic article) machine servicing information applicable to diagnostic data stored in machine memory. The references of record neither anticipate nor render obvious the recited invention of claim 18.

Claim 20

The references, taken alone or in combination, further do not teach or suggest operating an automated banking machine to output tool data to enable the significance of outputted diagnostic information to be provided. The references of record neither anticipate nor render obvious the recited invention of claim 20.

No Additional Claim Fee

There are twenty (20) total claims pending, including three (3) independent claims. Thus, no claim fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Response and any other fee due to Deposit Account 09-0428.

Conclusion

The cited prior art is devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce Applicant's invention. Thus, Applicant respectfully submits that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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